

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE RECEIVED

Applicants : Hill *et al.*
Application no. : 09/707,730
Confirm. no.: : 8812
Filed : November 6, 2000
For : COMPOUNDS FOR INTRACELLULAR
DELIVERY OF THERAPEUTIC MOIETIES TO
NERVE CELLS
Group art unit : 1647
Examiner : Sharon L. Turner, Ph.D.

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TO: Examiner Sharon Turner
Hon. Commissioner for Patents
Washington, D.C. 20231

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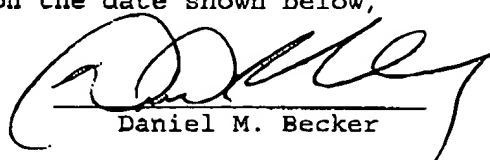
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November 14, 2002
Date


Daniel M. Becker

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PATENTS

Attorney Docket No. ASILMR-2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

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M.G.J
12/3/02

Palo Alto, CA
November 14, 2002
By Facsimile

Hon. Commissioner for Patents
P.O. Box 2327
Arlington, Virginia 22202

REQUEST FOR SHIFT IN INVENTION

Sir:

In response to the notice of Non-Responsive Amendment
mailed October 30, 2002, applicants respectfully request
reconsideration and permission to shift invention.

The instant application was filed November 6, 2000. In a first action, mailed March 26, 2002, the Examiner restricted claims 1 - 25 into two groups, the first "drawn to a method of improving intracellular administration of a therapeutic agent", the second "drawn to a compound", of which independent claim 13 is exemplary:

13. A compound comprising:

a charged derivative of a therapeutic agent having a therapeutic activity, the charged derivative being conjugated to a protein having a biological activity of being transported across a cell membrane into a cell, the cell metabolizing at least a portion of the compound to form a charged metabolite product that possesses the therapeutic activity of the therapeutic agent, the charged metabolite product being less prone to being transported across the cell membrane out of the cell relative to the compound and less prone to being transported across the cell membrane out of the cell relative to the therapeutic agent.

Power of attorney for this case was then transferred and the newly appointed attorney of record responded to the Restriction Requirement by canceling all claims and adding new claims 25 - 40, of which claim 25 is the sole independent claim:

25 (newly added). A conjugated 4-pregnen-21-hydroxy or 1,4-pregnadiene-21-hydroxy steroid, wherein the conjugant group pends from the steroid 21 hydroxyl group and comprises a neurotrophin or a neurotrophin receptor-binding fragment thereof.

The Notice of Non-Responsive Amendment followed.

"The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter."

M.P.E.P. § 819 (emphasis added). "While applicant, as a matter of right, may not shift from claiming one invention to claiming another, the Office is not precluded from permitting a shift."

M.P.E.P. § 819.01.

In the instant application, election has not been made nor action given on elected subject matter, and applicants request that the Office exercise its discretion in favor of permitting applicant to shift the invention to that now presently claimed.

Applicants note that neither Request for Continued Examination nor the filing of a Continued Prosecution Application is available to effectuate the change: as to the first, prosecution has not yet closed; as to the second, the November 2000 filing date of the application forecloses such action. The sole remaining route for effectuating a change in invention, the filing of a continuation application under 35 C.F.C. § 1.53(b), would substantially delay substantive examination of a case first filed two years ago and now docketed for examination.

Respectfully submitted,

14 NOV 2002

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